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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/505,632
Filing Date: February 16, 2000
Appellant(s): SCROGGIE ET AL.

MAILED

JUN 20 2007

GROUP 3600

Richard Neifeld
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/29/07 appealing from the Office action mailed 3/20/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Docket no: CAT/34-SCRO-CCP; application 09/505,632; BPAI appeal 2002-0329; decided 10/27/2003.

Docket no: CAT/34-SCRO-US; application 08/873,974; BPAI appeal 2004-1267; decided 7/29/2004; BPAI decision on reconsideration 9/30/2004.

Docket no: CAT/34-SCRO-US; application 08/873,974 CAFC docket No; 05-1164; remanded without decision.

Docket no: CAT/34-SCRO-US; application 08/873,974; BPAI appeal 2006-2100; awaiting decision.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,855,007	JOVICIC	12-1998
6,064,979	PERKOWSKI	5-2000
5,915,243	SMOLEN	6-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections

Claims 24-27, 36-39 and 48 are objected to because of the following informalities: As per independent claims 24, 36 and 48, these claims recite "transmitting region data from said web site of said manufacturer over the Internet **to a remote Web site**", and then "in response to receipt of region data **at said manufacturer's Web site**". This claim language is confusing since the region data is primarily transmitted to a remote site in the first limitation, and then is received at a manufacturer's Web site in the second limitation. Instead, the claim language should read "in response to receipt of region data **at said remote Web site**". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50 and 51 recites the limitation "transmission from a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "means for transmitting from a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 50, 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Jovicic et al.

As per claims 50, 51 Jovicic et al discloses:

Transmission/Mean for transmitting from a consumer to a retailer website,
...(Col. 3, lines 47-50, user [uses computer] to make online selection to Internet Coupon Server, w/ Col. 7, lines 45-51, it is shown that the customer can select a coupon from the coupon server and send the coupon directly to the redemption center (retail outlet), therefore, while the consumer transmits data from a consumer to a coupon server as

shown in col. 3, lines 47-50, Jovicic additionally shows that the consumer also has the capability to transmit data to the redemption center (retail outlet));

Transmission/Mean for transmitting from the retailer website to a remote website, ...(Col. 3, lines 5-67, internet Coupon Notification Center records serial numbers of the coupons generated by the Internet Coupon Server [by way of redemption center] along with the redemption specification); and

Transmission/Mean for transmitting from the remote website to the retailer website, of a list of manufacturer incentives, ...(Col. 4, lines 47-53, accessing Coupon Notification Center's database to verify validity of electronic coupon at the redemption center, which records the redemption of coupons, and therefore comprises coupon details, which were transmitted to the database from the redemption center).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 27, 28, 29, 36, 39, 40, 41, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007).

As per claim 24, 36, 48, 49, Jovicic et al discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a

product and a service offered by said manufacturer/means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer, (col. 3, lines 47-50, user makes online selection to the Internet Coupon server, by way of redemption center, as shown in Fig. 1 where [122] is used for making a selection and is connected to the redemption center);

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 9, line 65-Col. 10, line 17, shows that the user enters demographic information such as location data to Internet Coupon Server, w/ col. 3, lines 34-38 shows that the Internet coupon server records transactions to the coupon's

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Internet Coupon Notification Center, therefore, when the Internet coupon server records transactions to the coupon's Internet Coupon Notification Center, this event suggests that the server is recording location data);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/means for transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/ in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives, (Col. 10, line 46-Col 11, line 3, In response to entry of demographic information, transmission of coupon serial number and redemption center's ID # to the Internet Coupon Notification Center's database occurs) by way of message;

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address/ in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 11, lines 8-12, shows that as a result of the transmitted message, the coupon's serial number and the user's identification is stored in the coupon generation database, which is accessible by the consumer).

Jovicic et al does not specifically disclose that the request goes to the Web site of the manufacturer, but does disclose that the user request goes through the Internet to the Internet coupon Server. In Fig. 1, it is shown that Internet Public Computer Network [122] is connected to the Redemption Center (retailer as shown in Col. 2, line 27), and manufacturer (Internet Coupon Notification Center since manufacturer is known to be the issuer as shown in col. 2, line 6), which are all connected to the Internet Coupon Server by an Internet Connection. Therefore, it would be obvious to make a request to the manufacturer since the consumer makes a request over the Internet by way of the retail outlet, and the retail outlet is also connected to the manufacturer outlet through the Internet connection, the manufacturer's Web page is also therefore being utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to direct a request to the Web site of the manufacturer with the motivation of allowing a consumer to directly interact with the product incentive request environment.

As per claim 27, 39, Jovicic et al discloses:

transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive/means for transmitting... (Col. 3, lines 47-50, user makes online selection to Internet Coupon Server);

transmitting from said Web site of said manufacturer to said remote site said selection data/means for transmitting from said Web site...(Col. 3, lines 5-67, internet Coupon Notification Center records serial numbers of the coupons generated by the Internet Coupon Server[by way of redemption center] along with the redemption specification);

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive/means for transmitting from said remote site...(Col. 4, lines 47-53, accessing Coupon Notification Center's database to verify validity of electronic coupon at the redemption center, which records the redemption of coupons, and therefore comprises coupon details);

transmitting from said Web site of said manufacturer to said consumer computer details/means for transmitting from said Web site of said manufacturer, (Col. 11, lines 8-12, shows that as a result of the transmitted message, the coupon's serial number and the user's identification is stored in the coupon generation database, which is accessible by the consumer).

Jovicic et al does not specifically disclose that the request goes to the Web site of the manufacturer, but does disclose that the user request goes through the Internet to the Internet coupon Server. In Fig. 1, it is shown that Internet Public Computer Network [122] is connected to the Redemption Center (retailer as shown in Col. 2, line 27), and manufacturer (Internet Coupon Notification Center since manufacturer is known to be the issuer as shown in col. 2, line 6), which are all connected to the Internet Coupon

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Server by an Internet Connection. Therefore, it would be obvious to make a request to the manufacturer since the consumer makes a request over the Internet by way of the retail outlet, and the retail outlet is also connected to the manufacturer outlet through the Internet connection, the manufacturer's Web page is also therefore being utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to direct a request to the Web site of the manufacturer with the motivation of allowing a consumer to directly interact with the product incentive request environment.

As per claim 28, 40, Jovicic et al discloses:

transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, ...(Col. 3, lines 47-50, user makes online selection to Internet Coupon Server);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, ...(Col. 3, lines 5-67, internet Coupon

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Notification Center records serial numbers of the coupons generated by the Internet Coupon Server[by way of redemption center] along with the redemption specification);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; ...(Col. 4, lines 47-53, accessing Coupon Notification Center's database to verify validity of electronic coupon at the redemption center, which records the redemption of coupons, and therefore comprises coupon details);

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 11, lines 8-12, shows that as a result of the transmitted message, the coupon's serial number and the user's identification is stored in the coupon generation database, which is accessible by the consumer).

As per claims 29, 41, Jovicic et al discloses:

Transmitting/means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification, (Col. 4, lines 30-47, placing coupon indicia in browsing memory based on user identification).

Claims 25, 26, 30, 37, 38, and 42, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al (US 5,855,007), in further view of Perkowski (US 6,064,979).

As per claim 25, 37, Jovicic et al does not disclose the following, but does disclose Internet connections as shown in Fig. 1, however Perkowski discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link to a Web site of said retailer/wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 4, lines 45-52, shows URLs are symbolically linked to each registered product). Perkowski discloses this limitation in an analogous art for the purpose of showing that a user can utilize a URL to access product data).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit a link to a Web site with the motivation of transmitting means for accessing product data over an Internet connection.

As per claim 26, 30, 38, 42, Jovicic et al does not disclose the following, but does disclose utilizing demographic data such as location data to obtain coupons through the Internet Coupon Server as shown in Col. 9, line 65-Col. 10, line 17, however Perkowski discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site/means for determining...transmitting from the

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consumer computer over the Internet to the Web site of the retailer region data/means for transmitting...(Col. 1, lines 54-64, shows it is common to use search by location of the seller's site via search engines to determine that seller's product information, where it is shown that product information includes company name and company e-mail address since this is some of the information stored in the IPSD server and it is therefore the same type of information that is transmitted by the IPSD Web site). Perkowski discloses this limitation in an analogous art for the purpose of showing that a user can use a search engine to determine product information.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to utilize region data in a query to determine at least one name and address of a retailer with the motivation of allowing a user to search for the specific location of a retailer only with limited information.

Claims 31 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al, (US 5,855,007), in further view of Perkowski (US 6,064,979), and further in view of Smolen (US Patent 5,915,243).

As per claims 31, 43, neither Jovicic et al nor Perkowski disclose wherein said region data is postal code data, but Jovicic et al does disclose region data through collecting demographic data in col. 9, line 65-Col. 10, line 17.

However Smolen discloses:

wherein said region data is postal code data, (Col. 4, lines 64-67, represented by postal code). Smolen discloses this limitation in an analogous

art for the purpose of showing that postal code data can be incorporated into a system for transmitting incentives.

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine the location of the retailer versus the location of the user for incentive transmittal purposes.

(10) Response to Argument

As per claim 24, appellant argues that Jovicic fails to disclose "transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentive to purchase one of a product and a service offered by said manufacturer since, according to appellant, Jovicic does not disclose that the coupons served by its coupon server are coupons by the entity owning the coupon server. However, in this case, ownership is not patentable subject matter. Nowhere in claim 24 does appellant disclose that the server is owned by the manufacturer. In addition, Jovicic discloses that Internet coupons are received from the Internet coupon server's supplier in col. 3, lines 52-54, and in Internet applications, it is possible for an entity to have a website, and not necessarily own the server. For example, if one goes through Myspace.com to create his or her own website, they can achieve this without owning the Myspace server.

As per claim 24, appellant also argues that Jovicic does not disclose the transmission of region data to a remote Web site in response to a request to the manufacturer web site for incentives. Appellant admits that Jovicic does disclose that the coupon server notifies the coupon notification center of each coupon it provides to

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the user, but does not disclose that the notification contains region data. However, col. 3, lines 34-38 shows that the Internet coupon server records transactions to the coupon's Internet Coupon Notification Center. Also, in col. 10, lines 12-17, it is shown that the user must enter in location data into the coupon server in order to make a transaction, therefore making location data part of transaction data. Therefore, when the Internet coupon server records transactions to the coupon's Internet Coupon Notification Center, this event suggests that the server is recording location data.

As per claims 36, 48 and 49, these claims are rejected for the same reasons as discussed with respect to claim 24.

As per claim 28, this claim is rejected for the same reasons as discussed with respect to claim 24.

As per claim 40, this claim is rejected for the same reasons as discussed with respect to claim 28.

As per claims 25, 26, 30, 37, 38 and 42, these claims are rejected for the same reasons as discussed with respect to claim 24.

As per claims 31 and 43, these claims are rejected for the same reasons as discussed with respect to claim 24.

As per claims 24-27, 36-39 and 48, appellant argues that the objection to these claims is incorrect since, according to appellant, the specification indicates that generally every time the manufacturer's web site receives region data, the remote site responds by "transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of

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a retailer". However, as the claim states: "transmitting region data from said web site of said manufacturer over the Internet *to a remote Web site*" and then "in response to receipt of region data at said manufacturer's Web site", how can the receipt of region data at a manufacturer's Web site be in response to the transmission if at first, the region data is located at the remote web site? Because of the wording of the claim, the claim is confusing and gives the examiner a difficult time interpreting the claim.

As per claims 50 and 51, appellant argues that the 35 USC 112 rejection to these claims is incorrect. Appellant argues tat examiner has not identified what specific recitation allegedly lacks antecedent basis. However, as disclosed above in the rejection, the limitation "transmission from a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "means for transmitting from a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51 lack antecedent basis since there is no indication *in the claims* as to what is being "transmitted" prior to the transmission steps.

In addition, as per claims 50 and 51, appellant argues that Jovicic fails to disclose these claims since it is not shown that Jovicic discloses that its coupon server is a retailer web site. However, in Col. 7, lines 45-51, it is shown that the customer can select a coupon from the coupon server and send the coupon directly to the redemption center (retail outlet), therefore, while the consumer transmits data from a consumer to a coupon server as shown in col. 3, lines 47-50, Jovicic additionally shows that the consumer also has the capability to transmit data to the redemption center (retail outlet).

(11) Related Proceeding(s) Appendix

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Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Akiba Robinson-Boyce



Conferees:

Igor Borissov

